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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,351	12/21/2001	Gilles Rubinstenn	05725.1009-00	4841
22852	7590	04/05/2007		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3628	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/024,351	Applicant(s) RUBINSTENN ET AL.	
	Examiner Igor N. Borissov	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 10/7/11/2006 is acknowledged and entered. Claims 1-30 are currently pending in the application.

Claim Rejections - 35 USC § 112

Claim Rejections under 35 USC § 112 have been withdrawn due to the applicant's amendment.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a "useful, concrete and tangible result" is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "useful, concrete and tangible result". The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with

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the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

The claims, as currently recited, appear to be directed to nothing more than asking a subject *personal questions*, and, based on the received *answers to the personal questions* selecting from a plurality of testing materials at least one customized set of testing material. The examples of type of questions provided by the specification include questions regarding a subject's physical characteristics, lifestyle, demographics, environment, sun exposure level, nutrition, cosmetic usage, or any other information including a subject's age, weight, height, ethnicity, size and proportion of facial features, habits of working, sleeping, exercise, relaxation, cleansing and moisturizing, exfoliation, smoking, and drinking. The answers received for such types of questions are clearly subjective, and would differ from subject to subject, thereby providing no indication of concreteness of the result. Accordingly, the claimed invention does not appear to provide concrete result and is, therefore, deemed to be non-statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney et al. (WO 01/18674 A2) in view of Falla (US 4,122,947).

Maloney et al. (hereinafter Maloney) teaches a method, system and computer-readable medium for providing a customized product combination to a consumer, comprising:

Independent Claims

Claims 1, 11 and 20.

Asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject (page 11, lines 26-30);

receiving answers to the personal questions (page 11, lines 26-27);

based on the received answers, providing the subject with at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject (page 11, lines 7-9), said "providing" step indicates a step of *selecting* of said at least one customized set of testing material;

informing the subject about said at least one customized set of testing material (page 11, lines 13-14).

While Maloney teaches *selecting* of said at least one customized set of testing material, Maloney does not specifically teach selecting *from a plurality of testing materials* said at least one customized set of testing material.

Falla teaches a pre-packaged patient identification kit including patient identification indicia and at least one specimen container (Abstract), wherein said identification indicia indicates "customizing" feature.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said "selecting" step includes selecting from a *plurality of testing materials* said at least one customized set of testing material, as suggested in Falla, because it would advantageously allow to accommodate said various profile sub-categories of consumers, thereby providing each customer with said customized test kit (Maloney; page 11, lines 6-10).

Claim 24.

Asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject (page 11, lines 26-30);

receiving answers to the personal questions (page 11, lines 26-27);

based on the received answers, providing the subject with at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject (page 11, lines 7-9), said "providing" step indicates a step of *selecting* of said at least one customized set of testing material;

providing the subject with the customized set of testing material (page 11, lines 13-14);

ascertaining quantitative information by collecting data derived from use of the testing material on the subject (page 11, lines 15-16, 19-20);

recommending at least one beauty product to the subject based on the received answers and the ascertained quantitative information (page 12, lines 27-33).

While Maloney teaches *selecting* of said at least one customized set of testing material, Maloney does not specifically teach selecting *from a plurality of testing materials* said at least one customized set of testing material.

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Falla teaches a pre-packaged patient identification kit including patient identification indicia and at least one specimen container (Abstract), wherein said identification indicia indicates "customizing" feature.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said "selecting" step includes selecting from a *plurality of testing materials* said at least one customized set of testing material, as suggested in Falla, because it would advantageously allow to accommodate said various profile sub-categories of consumers, thereby providing each customer with said customized test kit (Maloney; page 11, lines 6-10).

Claim 25.

receiving information regarding at least one external body condition of a subject (page 11, lines 26-30);

based on the received information, providing the subject with at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject (page 11, lines 7-9), said "providing" step indicates a step of *selecting* of said at least one customized set of testing material;

informing the subject about said at least one customized set of testing material (page 11, lines 13-14).

While Maloney teaches *selecting* of said at least one customized set of testing material, Maloney does not specifically teach selecting *from a plurality of testing materials* said at least one customized set of testing material.

Falla teaches a pre-packaged patient identification kit including patient identification indicia and at least one specimen container (Abstract), wherein said identification indicia indicates "customizing" feature.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said "selecting" step includes selecting from a *plurality of testing materials* said at least one customized set of testing material, as suggested in Falla, because it would advantageously allow to

accommodate said various profile sub-categories of consumers, thereby providing each customer with said customized test kit (Maloney; page 11, lines 6-10).

Dependent Claims

Claim 2. Providing the subject with the customized set of testing material (page 11, lines 13-14).

Claim 3. See reasoning applied to claim 2.

Claim 4. Ascertaining quantitative information by collecting data derived from use of the testing material on the subject (page 11, lines 15-16, 19-20).

Claim 5. Recommending at least one beauty product to the subject based on the received answers and the ascertained quantitative information (page 12, lines 27-33).

Claim 6. Said method and system, wherein the customized set of testing material includes at least one of a pH indicator, sebutape, and a corneodisque indicator (page 11, lines 11-12).

Claim 7. Said method and system, wherein the questions are posed to the subject over a computer network (page 8, line 35 – page 9, line 2), and wherein the at least one customized set of testing material is delivered to the subject via a courier (column 11, line 18).

Claim 8. Maloney teaches selecting and shipping an appropriate (customized) set to a customer (page 11, lines 7-9 and 18), (see reasoning applied to Claim 1). As to *maintaining an inventory of a plurality of differing groups of customized sets of testing material, each group containing a combination of testing material different from a combination in another group*, and wherein providing the subject with a customized set includes selecting and shipping an appropriate set *from a group maintained in inventory*, Maloney teaches profiling a consumer based on consumer's physiological preferences and physiological conditions, said conditions including skin type and life stage, said profiling further includes assigning the consumer to various profile sub-categories which correspond to specific beauty product categories (page 6, line 32 – page 7, line 12), thereby indicating that said selected (customized) set is readily available for each consumer in each of said profile sub-categories.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include *maintaining an inventory of a plurality of differing groups of customized sets of testing material, each group containing a combination of testing material different from a combination in another group*, and wherein providing the subject with a customized set includes selecting and shipping an appropriate set *from a group maintained in inventory*, because it would advantageously allow to accommodate said various profile sub-categories of consumers, thereby providing each customer with said test kit (page 11, lines 6-10).

Claim 9. See reasoning applied to claim 2.

Claim 10. See reasoning applied to claim 2.

Claim 12. See reasoning applied to claim 2.

Claim 13. See reasoning applied to claim 4.

Claim 14. See reasoning applied to claim 5.

Claim 15. See reasoning applied to claim 6.

Claim 16. See reasoning applied to claim 7.

Claim 17. See reasoning applied to claim 8.

Claim 18. See reasoning applied to claim 9.

Claim 19. See reasoning applied to claim 10.

Claim 21. See reasoning applied to claim 2.

Claim 22. See reasoning applied to claim 4.

Claim 23. See reasoning applied to claim 5.

Claim 26. Said method, wherein the information is chosen from answers to questions and at least one representation of the external body condition (image of the subject) (page 11, lines 26-30; page 20, lines 27-34).

Claim 27. Said method, wherein the information is an image of the external body condition (page 20, lines 27-34).

Claim 28. See reasoning applied to claim 16.

Claim 29. See reasoning applied to claim 2.

Claim 30. See reasoning applied to claim 6.

Response to Arguments

Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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3/31/2007

IGOR N. BORISSOV
PRIMARY EXAMINER

